



Docket No.: 246883US0

TM

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/736,711

Applicants: Johann LEBAN, et al.

Filing Date: December 17, 2003

For: COMPOUNDS AS ANTI-INFLAMMATORY,
IMMUNOMODULATORY AND ANTI-
PROLIFERATORY AGENTS

Group Art Unit: 1621

Examiner: S. Kumar

SIR:

Attached hereto for filing are the following papers:

Response to Restriction and Election of Species Requirement

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

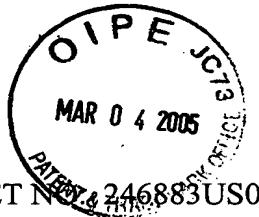


Donald K. Drummond, Ph.D.
Registration No. 52,834

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)



DOCKET NO. 246883US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

JOHANN LEBAN, ET AL. : EXAMINER: KUMAR, S.

SERIAL NO: 10/736,711 :

FILED: DECEMBER 17, 2003 : GROUP ART UNIT: 1621

FOR: COMPOUNDS AS ANTI-
INFLAMMATORY,
IMMUNOMODULATORY AND ANTI-
PROLIFERATORY AGENTS

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated February 16, 2005, Applicants elect, with traverse, Group I: Claims 1-2 and 4-6, drawn to non-heterocyclic compounds for examination. In addition, Applicants elect, with traverse, for search purposes only, the species Example 5 listed on page 34 of the specification. Claims 1, 5 and 6 read on the elected species.

REMARKS/ARGUMENTS

The Examiner is requiring restriction of the above-identified application as follows:

Group I: Claims 1-2 and 4-6, drawn to non-heterocyclic compounds;

Group II: Claims 1-2 and 4-6, drawn to heterocyclic compounds;

Group III: Claim 3, drawn to bicyclic compounds; and

Group IV: Claims 7-18, drawn to method of use.

Applicants have elected with traverse, Group I: Claims 1-2 and 4-6, drawn to non-heterocyclic compounds for examination. In addition, Applicants elect, with traverse, for search purposes only, the species Example 5 listed on page 34 of the specification. Claims 1, 5 and 6 read on the elected species.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. § 803). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing sufficient reason and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has categorized the relationships between Groups I, II and IV as product and process of use. Patentable distinctness may be shown if either or both of the following can be shown: (A) that the process of using as claimed can be practiced with another materially different product or (B) that the product as claimed can be used in a materially different process (M.P.E.P. § 806.05(h)).

The Examiner states that "...the product as claimed can be used in a materially different process of using such as evidenced by instant method Claim 5." However, the Examiner has not provided a sufficient example or reason to support the materially different criteria required under § 806.05(h)). Therefore, the Examiner's reasoning is nearly a restatement of the Examiner's conclusion that the groups are patentably distinct. As the Examiner has provided insufficient reasons in support of this belief, the Examiner has not met the required burden, and accordingly, the restriction is believed to be improper and should be withdrawn.

The Examiner also contends that Groups I, II and III are unrelated and that restriction is proper under M.P.E.P. §§806.04 and 808.01 because “Group III can be used separately independent of Group I or II compounds.” However, the Examiner has not provided a sufficient example or reason to support the criteria required under §§806.04 and 808.01. Therefore, the Examiner's reasoning is nearly a restatement of the Examiner's conclusion that the groups are patentably distinct. As the Examiner has provided insufficient reasons in support of this belief, the Examiner has not met the required burden, and accordingly, the restriction is believed to be improper and should be withdrawn.

Applicants have also elected claims drawn to products. Applicants request that if the claims drawn to the products are found allowable, that the withdrawn method claims that depend from or otherwise include all the limitations of the allowable product claims be rejoined (M.P.E.P. §821.04).

In addition, Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion. Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed (MPEP § 808.01(a)). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Election of Species Requirement. Withdrawal of the Election of Species Requirement is respectfully requested.

Application No. 10/736,711

'Reply to Office Action of February 16, 2005

With respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Finally, Applicants respectfully submit that the Office has not shown that a serious burden exists in searching the entire application.

Applicants submit this application is now in condition for examination on the merits and early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Donald K. Drummond, Ph.D.
Registration No. 52,834

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
DKD/rac:aps